Domestic Priority Claim

Please confirm that the specification has been amended to claim domestic priority as requested in the paper filed April 28, 2004.

Title of Invention

The undersigned thanks the Examiner for reconsidering the objection to the title. As the objection was not maintained, it is understood to be withdrawn.

Section 112 Rejection

The undersigned thanks the Examiner for reconsidering the rejection of claim 12 under 35 U.S.C. § 112, first paragraph, for lack of enablement. As the rejection was not maintained, it is understood to be withdrawn.

Combination of References for Obviousness Rejection

In the Office Action, a paragraph spanning the boundary between page 3 and page 4 acknowledges the legal requirement for a suggestion or motivation in the art to support a combination of Braun and Pearcy under Section 103. But the Office Action provides no evidence to support that combination. It merely asserts without support that the combination would improve reliability and flexibility. As discussed in the Amendment filed April 28, 2004, retroactively defining the motivations of one of skill at the time in terms of advantages which are only now appreciated is not proper. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

It is not clear that the asserted combination of Braun and Pearcy would even operate. Pearcy assumes that the PST file is removed from the C: partition; Outlook "can't find the PST file" after it is dragged to a folder in the D: partition on the same computer. By contrast, the sections of Braun cited in the Office Action discuss movement of configurations between two computers. Braun and Pearcy thus make inconsistent assumptions about where to find configuration files, so operability of the combination should not be assumed.

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Even if combining Braun and Pearcy did improve reliability and flexibility, the Office has given no *evidence* that one of skill who was trying to improve reliability and flexibility would have been led by something specific in the prior art to make that improvement by combining Braun and Pearcy. For instance, it has not been shown that combining Braun and Pearcy was the *only* way to improve reliability and flexibility, and the Office Action does not explain why one of skill would have chosen to combine Braun and Pearcy instead of trying something else.

As noted earlier, the mere fact that references can be combined (if that is even true in this case) does not mean the combination is obvious. *M.P.E.P.* § 2143.01. To establish a *prima facie* case of obviousness, the Office must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *M.P.E.P.* § 2142. The prima facie case must be based on *evidence*, not on unsupported statements; *see* cases cited in the April 28, 2004 Amendment.

The only asserted basis for combining McCall with the other references likewise fails, for lack of specific evidence to support the combination. The mere fact that adding McCall would improve Braun's performance – even if that were true – does not by itself justify combining McCall with Braun, much less combining McCall with Braun and Pearcy.

In short, the Office has not met its burden. No factual evidence of specific suggestions in the art were given to justify the combinations relied by the rejections. Without the necessary factual evidence of a suggestion or motivation for making a combination at the time, the combination is not proper. For at least this reason, the rejections should be withdrawn.

Official Notices

As to the Official Notice taken in connection with claims 4 and 5, Applicants and Assignee agree that bootable removable storage media and network boot images were well known. They challenge the obviousness and inherency assertions, however.

As to the Official Notice taken in connection with claim 14, Applicants and Assignee agree that rollback images were well known, and that deploying rollback images in some manner was also known. They further agree that Pearcy teaches a rollback image installation in the C:

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partition. However, they maintain that combining rollback images with the other claim limitations would not have been obvious.

Braun Fails to Teach "In Place" Limitations

As explained in the Amendment filed April 28, 2004 Braun does not teach the "in place" limitations of the claimed invention. The present Office Action does not rebut that point, but instead merely repeats the unsupported rejection language from the previous office action. Applicants and Assignee await an action by the Office which addresses their previous argument. Without such action, the rejections are all improper.

Pearcy and Braun Each Fail to Teach "Restoring Migration Content" Limitations

Braun does not teach the limitations in claim 1 and claim 19 of "restoring migration content from the migration content storage partition" because under the claims' providing steps, the migration content storage partition is in the computer system. It is not on another computer system as taught by Braun. That is, Braun might be restoring migration content, but Braun is clearly not restoring migration content "from the migration content storage partition".

Pearcy does not restore migration content. At most, Pearcy moves migration content to another partition and leaves it there. The PST file is moved from the C: partition to the D: partition, but it is not restored to the C: partition. Instead, it is evidently left on the D: partition, because Outlook's settings are changed to refer to it there.

Combining Pearcy with Braun would produce an operability conflict, because the Braun technology would apparently expect to receive configuration information at its original location after downloading an image from a network, while the Pearcy technology would expect to reference configuration information at a new location without necessarily using a network.

All rejections based on Pearcy and/or Braun in the claim trees for claim 1 and claim 19 should be withdrawn.

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Pearcy Fails to Teach Extended Partitions

As to claims 8 and 9, Pearcy does not teach extended partitions. The mere fact that a certain characteristic *may* occur in the prior art is not sufficient to establish the inherency of that characteristic. *M.P.E.P.* § 2112(IV). Extended partitions are not necessarily a part of the system disclosed in Pearcy, and they are not mentioned by Pearcy. It is thus improper to rely on Pearcy to reject these claims.

McCall Fails to Teach Deleting to Make Room for Migration Content

As to claims 2 and 20, the cited portions of McCall teach creating a dummy file filled with a signature value, in order to write that signature in all previously unused space on a storage medium so the backup program can determine which parts of the medium to copy. After the signature has been written to the space, thereby distinguishing space containing data the user wants copied from space containing data that need not be backed up, the dummy file is deleted. Thus, the file is not deleted to make room for migration content, but is instead deleted because it was an artifact of the signing process, and because if it is not deleted the user will have no free space left on the medium. It is therefore improper to rely on McCall to reject these claims.

Final Action

Applicants and Assignee respectfully request that the Examiner's next action be final.

Conclusion

In light of the above, Applicants and Assignee respectfully submit that the application is in condition for allowance. Their silence here as to any point does not signify agreement or acquiescence in the Office's assertions, and they reserve all arguments.

If any impediment to the allowance of these claims remains after entry of this Response, the Examiner is strongly encouraged to call John Ogilvie at 801-566-6633 so that such matters may be resolved as expeditiously as possible.

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The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Response to Deposit Account No. 20-0100.

DATED this 17th day of August, 2004.

Respectfully submitted,

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